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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,384	11/08/2001	Gregory Wright	215760US28	5139
22850	7590	03/28/2006		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BRINICH, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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20060308

DATE MAILED:

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Commissioner for Patents

<b>Office Action Summary</b>	<b>Application No.</b> 09/986,384	<b>Applicant(s)</b> WRIGHT, GREGORY	
	<b>Examiner</b> Stephen M. Brinich	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/22/05, 12/20/05</u> . | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3-7, 9-13, & 15-18, insofar as they are understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hitachi Koki Imaging Solutions, Inc. "The Internet Document Controller" (October 2000).

Re claims 1, 7, & 13, The Internet Document Controller discloses (pages 3-4, **"i-manage: Remote Device Management"** and **"i-service: More Machine Uptime"**) a method and apparatus for monitoring a remote image forming device in which a "remote device management" facility receives information representing an image forming device condition (**"i-service: More Machine Uptime"**, page 4 - the described "remote device management" inherently require the transmission of device condition information from the device to the site where the remote diagnosis described under **"i-service: More Machine Uptime"** occurs). This device condition information includes (page 4, middle right figure indicating the display at the remote location) a first parameter indicating a number of pages which, when exceeded, will trigger a display of a "maintenance warning" message and a second parameter indicating the number of pages

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printed by the device. The described "maintenance warning" message (to be triggered when the number of pages exceeds the indicated quantity) inherently requires that these two parameter values are compared and stored for at least long enough to carry out this comparison.

Re claims 1, 3, 6-7, 9, 13, & 15, The Internet Document Controller mentions ("**i-service: More Machine Uptime**", page 4) the running of a "diagnostic" (i.e. test) procedure is run on the remote image forming device. As noted above, The Internet Document Controller describes a "remote diagnostics" operation (i.e. the test is conducted at a location remote from the image forming apparatus). The above described operation of comparing a number of pages which, when exceeded, will trigger a display of a "maintenance warning" message and the number of pages printed by the device subsequent to such a diagnostic procedure would thus read on the claim requirement that the recited parameter is obtained after the remote image forming device is operated to execute a test operation.

Re claims 4-5, 10-11, & 16-17, The Internet Document Controller discloses ("**i-service: More Machine Uptime**", page 4) the use of e-mail to communicate between the remote image forming device and the remote location that receives information representing an image forming device condition.

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Re claims 6, 12, & 18, The Internet Document Controller discloses ("**i-service: More Machine Uptime**", page 4) the performance of adjustments at the remote location to be transmitted to the remote image forming device resulting in a modification to the condition of the remote image forming device.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 8, & 14, insofar as they are understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over The Internet Document Controller.

Re claims 2, 8, & 14, The Internet Document Controller further discloses (page 4, middle right figure) a value (corresponding to the recited "tolerance") indicating a number of pages which, when exceeded, will trigger a display of a "maintenance needed" message (as distinguished from the previously described "maintenance warning" message). The

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described "maintenance needed" message (to be triggered when the number of pages exceeds the indicated quantity) inherently requires that the second parameter (number of pages printed) and the tolerance value (number of pages that will trigger the "maintenance needed" message) are compared and stored for at least long enough to carry out this comparison.

The Internet Document Controller does not describe a highlighted display of the "maintenance needed" message.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to highlight the "maintenance needed" message.

The suggestion/motivation for doing so would have been to distinguish this message from the (less immediately in need of attention) "maintenance warning" message.

Therefore, it would have been obvious to combine a standard message highlighted display with The Internet Document Controller to obtain the invention as specified in claims 2 & 8.

#### ***Response to Arguments***

5. Applicant's arguments filed 12/20/05 have been fully considered but they are not persuasive.

Applicant argues (12/20/05 Response: page 11, line 25 - page 12, line 14) that Hitachi fails to teach or suggest the claimed comparison of first parameter and a second parameter,

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and that the comparison is not an inherent feature of Hitachi. Re this issue, Applicant notes that inherency requires that the allegedly inherent feature "is necessarily present in the thing described by the reference" and "may not be established by probabilities or possibilities".

As noted above, the two relevant parameters are a page count threshold required to trigger a "maintenance warning" message (middle right figure on Page 4 of Hitachi) and an actual number of pages which have been printed. Hitachi describes (same figure) the relationship of these parameters as follows:

When this page count threshold is exceeded,  
a maintenance warning message is sent.

A determination of whether this page count threshold is exceeded (which, in this context, clearly means exceeded by the actual page count) inherently requires a comparison operation between this page count threshold and an actual number of pages which have been printed, since that determination gives a "true" result if and only if such a comparison determines that the latter exceeds the former.

Applicant argues (12/20/05 Response: page 12, line 15 - page 13, line 14) that Hitachi does not disclose or suggest



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conducting the claimed comparison at a location remote from the image forming apparatus.

As noted above, Hitachi describes (page 4, "**i-service: More Machine Uptime**") the use of "remote diagnostics". The term "diagnostics" as understood by one of ordinary skill in the art (a sensing and analysis of the condition of a device) would clearly include the above described comparison used to determine when to send a "maintenance warning" message.

#### **Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.

The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

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Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Stephen M Brinich  
Examiner  
Technology Division 2625

smb   
March 9, 2006



THOMAS D. LEE